

## **REMARKS**

In this response, Claims 22, 32, and 42 are amended, and Claims 23, 28, 33, and 38 are canceled without prejudice or disclaimer. Accordingly, Claims 22, 27, 29-32, 37, and 39-42 are still pending in the present application.

### **Canceled Claims**

Applicant canceled Claims 23, 28, 33, and 38 without prejudice or disclaimer and reserves the right to re-present these claims at a later time. As such, Applicant submits that the objections and rejections with respect to these claims are now moot. Accordingly, Applicant respectfully requests that the Examiner withdraw any objections and rejections directed to these claims.

### **Claim Objections**

Claims 22, 23, and 27-31 were objected to for usage of the functional language “configured that.” Claims 23 and 28 have been withdrawn and are not addressed here. Claims 22 and 31 have been amended as per the examiner’s suggestion. Accordingly, Applicant requests that the objection be withdrawn.

### **Rejections under 35 U.S.C. §101**

Claims 32, 33, and 37-41 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Amended independent Claim 32 is directed to a method for information processing in an information processing apparatus using a database to store registered trademark image information and genuine-product-specific information corresponding to a product name. The method claim as recited in Claim 32 is now clearly tied to an information processing apparatus (a machine) and now satisfies the statutory claim type of 35 U.S.C. §101. As such, the claim rejections of Claim 32 and its dependent claims are believed to be overcome.

Rejections under 35 U.S.C. §103

Claims 22, 23, 30-33 and 40-42 were rejected under 35 U.S.C. § 130(a) as being unpatentable over Kaish et al. (US 5,974,150, hereinafter “KAISH”) in view of the Microsoft Computer Dictionary, Fifth Edition, (hereinafter “MICROSOFT”).

Claim 22 recites, *inter alia*, “...a determining unit programmed to determine ... that the product is a third party product when the determining unit determines that the product data input by the input unit does not include the registered trademark image information in the database corresponding to the product name input in the input screen; and a notification unit programmed to notify that the product is not a counterfeit product when the product is determined to be a genuine product or a third party product by the determining unit and to notify that the product is a counterfeit product when the product is determined to be a counterfeit product by the determining unit.”

An aspect of the present invention is the determination of whether the scanned product is a genuine product, a counterfeit product, or a third party product. This can be accomplished by using the registered trademark image information and the genuine-product-specific information.

Applicant submits that KAISH does teach the above-noted features. KAISH is directed to determining genuineness by using an encrypted code, and a product is determined to be a counterfeit product when the product does not have an encrypted code. KAISH is not even directed to determining third party product.

In contrast, the present invention first determines whether the product displays registered trademark image information in the database corresponding to the product name input in the input screen., if it does not the present invention determines the product to be a third party product and does not proceed to look for a secondary piece of information indicating genuineness.

On pages 6-7 of the present Office Action the Examiner argued that a human would look at a toner from another company (such as Samsung), realize it was from a company other than Canon and not attempt to recognize it as a Canon toner and adding this as an automatic capability to a counterfeit detection system would be obvious to one skilled in the art. Assuming *arguendo* that this would be obvious to one skilled in the art, it does not take into account the advantage to the user of being able to determine if the

Samsung toner is a genuine Samsung toner. In the present invention, any product with trademark and authentication information found in the database can be tested for genuineness and products whose trademark information is not found in the database are assumed to be third party products and are not tested further. So while a human can determine that a toner is not a Canon toner and therefore not need to ask whether it is a genuine Canon toner, the question of whether the second companies toner is genuine is one that is specifically answered by the present invention unless the trademark information of the second company is not contained in the database in which case it is determined to be a third party toner. This is of significant advantage to the user, since a counterfeit product of any company is not what it appears to be and while a genuine product from another company might be just as safe for the user's equipment, a counterfeit product does not provide the same guarantees.

Additionally, KAISH does not teach of suggest the notification feature of Claim 22 cited above. The present invention automatically notifies the appropriate authority terminal of a determined counterfeit product. Automatic notification of the appropriate authority with all of the necessary information regarding the counterfeit product is a significant advantage to the user and the company concerned with the counterfeiting of its products. In order to do the same thing manually, the user would have to look up who to notify and how to do so, either by snail mail or phone call; would have to collect all of the pertinent information such as where the product was purchased, when it was purchased, and how the person knows the product to be a counterfeit; and then would have to prepare the letter or make the phone call. All of this takes a considerable amount of time and is subject to human error. By providing an automatic notification feature, the present invention saves the user time, preserves accurate information and provides verified determination of a counterfeit product. Receiving timely information of a counterfeit product allows the regulatory authority to move quickly to intercept additional counterfeit products or interfere with the creation or distribution of such products. Relying on busy human beings to provide this notification significantly slows the process.

Likewise, Applicant submits that MICROSOFT does not teach the above-noted features. As described above, amended Claim 22 includes features not taught or

suggested by KAISH and MICROSOFT, when taken either alone or in combination. Claim 22 is not rendered obvious by KAISH and MICROSOFT. Claim 22 is believed allowable. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of Claim 22.

Amended Claims 32 and 42 include similar features to Claim 22 and are believed allowable for at least the same reasons as Claim 22. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections of Claims 32 and 42.

The other pending claims that are rejected under 35 U.S.C. § 103(a) are each dependent from the independent claims discussed above and are therefore believed to be in condition for allowance for the same reasons. Because each dependent Claim is also deemed to define an additional aspect of the invention, however, the individual consideration of each on its own merit is respectfully requested.

Claims 27-30 and 37-40 were rejected under 35 U.S.C. § 130(a) as being unpatentable over KAISH in view of MICROSOFT and Admitted Prior Art. For the same reasons as provided above, Applicant submits that the rejection has been overcome and requests that the rejection be withdrawn.

### **CONCLUSION**

Any amendments to the Claims which have been made in this response which have not been specifically noted to overcome a rejection based upon prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

If any additional fee is required, please charge Deposit Account Number 502456.

Should the Examiner have any questions, the Examiner may contact Applicants' representative at the telephone number below.

Respectfully submitted,

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